

REMARKS

I. Introduction

Claims **1-36** and **38-39** are currently pending in the present application. Claims **3, 8, and 10-12** have been withdrawn from consideration, leaving claims **1-2, 4-7, 9, 13-36, and 38-39** remaining for consideration. Of the remaining claims, claims **1, 33, 36, and 38-39** are independent. All claims remaining for consideration stand rejected. In particular:

(A) claims **1-2, 4-7, 9, 13-36, and 38-39** stand rejected under non-statutory obviousness-type double patenting for allegedly being unpatentable over claims 1-63 of U.S. Patent No. 6,415,262 (hereinafter "Walker") in view of various forms of "Official Notice";

(B) claims **1-2, 4, 7, 15, 25, 27-28, 31-32, and 39** stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by U.S. Patent No. 5,870,459 (hereinafter "Phillips");

(C) claims **9, 13-14, 16-24, 28-30, and 33-36** stand rejected under §103(a) as being allegedly unpatentable over Phillips; and

(D) claims **5-6** stand rejected under §103(a) as being allegedly unpatentable over Phillips in view of U.S. Patent No. 4,799,156 (hereinafter "Shavit").

Upon entry of this amendment, which is respectfully requested, claims **1, 15, 20, 24, 26-28, 33, 36, and 39** will be amended solely to advance prosecution, and new claims **40-54** will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. Official Notice

Applicants respectfully incorporate by reference herein Applicants' remarks made in the previous response with respect to the Examiner's reliance on and use of Official Notice. In particular, Applicants respectfully reiterate that **Official Notice cannot be used to remedy deficiencies of the cited references** ("[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic

knowledge' or 'common sense.'" *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002)), as the Examiner continues to do. Further, **statements made by the Examiner do not constitute evidence** on the record and therefore cannot constitute Official Notice without being supported by an affidavit (for Officially noted personal knowledge) or a reference (for Officially noted matter alleged to have been known).

Applicants further respectfully note that the Examiner's retort to Applicants' previous remarks regarding Official Notice constitutes an attempt, by the Examiner, to shift the burden of Examination to Applicants, which is impermissible and contrary to statutory, regulatory, and case law. Particularly, since the Examiner has not provided any evidence of any allegedly Officially noted subject matter, such subject matter is not supported on the record and **the burden therefore remains with the Examiner** to provide the requisite evidence to support any attendant rejections based thereon.

Accordingly, Applicants respectfully request that all outstanding rejections based at least in part on Official Notice be withdrawn.

III. Claim 38

Applicants note that the Examiner indicates claim **38** is rejected solely under grounds of non-statutory Double Patenting. Accordingly, Applicants note that the filing of a Terminal Disclaimer and/or other traversal of the outstanding Double Patenting rejection of claim **38** would render claim **38** allowable.

IV. The Examiner's Rejections

A. *Double Patenting – Walker, Official Notice*

Claims **1-2, 4-7, 9, 13-36, and 38-39** stand rejected under non-statutory obviousness-type double patenting for allegedly being unpatentable over claims 1-63 of Walker in view of various forms of Official Notice.

At least because the Examiner relies upon improper and unsupported Official Notice to remedy the alleged deficiencies of Walker (See Section II herein), the Examiner

has not presented a *prima facie* case of obviousness of claims **1-2, 4-7, 9, 13-36, and 38-39**.

Applicants therefore respectfully request that this non-statutory obviousness-type double patenting ground for rejection of claims **1-2, 4-7, 9, 13-36, and 38-39** be withdrawn

B. §102(e) Rejections - *Phillips*

Claims **1-2, 4, 7, 15, 25, 27-28, 31-32, and 39** stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Phillips. Applicants traverse this ground for rejection as follows.

1. The reference fails to teach or suggest: *the benefit comprising a subsidy and the task being associated with a subsidy provider* (claims **1-2, 4, 7, 15, 25, 27-28, and 31-32)**

Applicants respectfully assert that Phillips fails to teach or suggest limitations of claims **1-2, 4, 7, 15, 25, 27-28, and 31-32**. For example, Phillips fails to teach or suggest *the benefit comprising a subsidy and the task being associated with a subsidy provider*.

The Examiner argues that the providing of the disposable telephone in Phillips is equivalent to the “benefit” recited in claim **1**. While Applicants continue to disagree with the Examiner’s interpretation of Phillips, claim **1** is nonetheless amended herein to point out (solely for purposes of advancing prosecution) that the “benefit” comprises a “subsidy”. Applicants respectfully submit that *no* interpretation of Phillips reads on such a limitation.

The Examiner also equates the disposable telephone collection entity described in Phillips to a “subsidy provider”. Applicants respectfully note that the entity described in Phillips simply collects used telephones and is potentially involved with returning security deposits. Nowhere is the entity described as providing a subsidy of any sort. Thus, the collection entity described by Phillips is not equivalent to a “subsidy provider”, as recited in claim **1**.

Accordingly, at least because Phillips fails to teach or suggest *the benefit comprising a subsidy and the task being associated with a subsidy provider*, Phillips fails

to anticipate claims **1-2, 4, 7, 15, 25, 27-28**, and **31-32**. Applicants therefore respectfully request that this §102(e) ground for rejection of claims **1-2, 4, 7, 15, 25, 27-28**, and **31-32** be withdrawn.

2. The reference fails to teach or suggest: *wherein the benefit comprises a monetary amount equivalent to the security deposit* (claim 39)

Applicants respectfully assert that Phillips fails to teach or suggest limitations of claim **39**. For example, Phillips fails to teach or suggest *wherein the benefit comprises a monetary amount equivalent to the security deposit*.

As described in Section B.1 herein, Phillips fails to teach or suggest the provision of a benefit comprising a monetary amount (e.g., a subsidy). Applicants further respectfully note that Phillips further fails to teach or suggest wherein the monetary amount is equivalent to the security deposit.

Accordingly, at least because Phillips fails to teach or suggest *wherein the benefit comprises a monetary amount equivalent to the security deposit*, Phillips fails to anticipate claim **39**. Applicants therefore respectfully request that this §102(e) ground for rejection of claim **39** be withdrawn.

C. §103(a) Rejections - Phillips

Claims **9, 13-14, 16-24, 28-30**, and **33-36** stand rejected under §103(a) as being allegedly unpatentable over Phillips. Applicants traverse this ground for rejection as follows.

1. The reference fails to teach or suggest: *the benefit comprising a subsidy and the task being associated with a subsidy provider* (claims **9, 13-14, 16-24, and **28-30**)**

Applicants respectfully assert that Phillips fails to teach or suggest limitations of claims **9, 13-14, 16-24**, and **28-30**. For example, Phillips fails to teach or suggest *the benefit comprising a subsidy and the task being associated with a subsidy provider*.

As described in Section B.1. herein, Phillips simply fails to teach or suggest multiple portions of the above-quoted limitation.

Accordingly, at least because Phillips fails to teach or suggest *the benefit comprising a subsidy and the task being associated with a subsidy provider*, Phillips fails to render obvious claims **9, 13-14, 16-24**, and **28-30**. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **9, 13-14, 16-24**, and **28-30** be withdrawn.

2. The reference fails to teach or suggest: [various factors] upon which the benefit is determined (claims 16-24)

Applicants respectfully assert that Phillips fails to teach or suggest limitations of claims **16-24**. For example, Phillips fails to teach or suggest *[various factors] upon which the benefit is determined*.

Nowhere does Phillips teach or suggest *various factors* (recited in claims **16-24**) *upon which a determination of the benefit is made*. Phillips does not, for example, teach or suggest determining the benefit based on: (i) transaction information (claim **16**); (ii) customer information (claims **17-18**); (iii) information associated with the task (claim **19**); (iv) information received from a customer device (claim **20**); (v) information associated with an item purchased by the customer (claims **21-22**); (vi) merchant information (claim **23**); or (vii) subsidy provider or customer acquisition information (claim **24**). Nor would any of these factors be obvious to include in Phillips since Phillips is directed, as interpreted by the Examiner, to providing the disposable telephone “benefit” to every customer of every transaction for wireless telephone time. Thus, Phillips does not require or even contemplate the need to determine which, if any, benefit should be provided. Indeed, Phillips, as interpreted by the Examiner, merely describes a single possible “benefit”, not a plurality of possible benefits that must be chosen or selected.

Accordingly, at least because Phillips fails to teach or suggest *[various factors] upon which the benefit is determined*, Phillips fails to render obvious claims **16-24**. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **16-24** be withdrawn.

3. The reference fails to teach or suggest: *wherein the benefit does not comprise a product* (claims 33-35)

Applicants respectfully assert that Phillips fails to teach or suggest limitations of claims 33-35. For example, Phillips fails to teach or suggest *wherein the benefit does not comprise a product*.

As described in Section B.1. and Section C.1. herein, Phillips describes providing a disposable telephone to customers. Even if this telephone could be construed as a “benefit” (which Applicants maintain it cannot), Phillips does not contemplate any other type or form of benefit, particularly wherein the benefit does not comprise a product.

Accordingly, at least because Phillips fails to teach or suggest *wherein the benefit does not comprise a product*, Phillips fails to render obvious claims 33-35. Applicants therefore respectfully request that this §103(a) ground for rejection of claims 33-35 be withdrawn.

4. The reference fails to teach or suggest: *wherein the task does not comprise a return of a product* (claim 36)

Applicants respectfully assert that Phillips fails to teach or suggest limitations of claim 36. For example, Phillips fails to teach or suggest *wherein the task does not comprise a return of a product*.

As related herein, Phillips describes a customer returning a disposable wireless telephone. Nowhere does Phillips contemplate any other task to be performed by the customer. Phillips does not, for example, contemplate the customer being required to “test drive a vehicle” or “purchase a supplemental item”.

Accordingly, at least because Phillips fails to teach or suggest *wherein the task does not comprise a return of a product*, Phillips fails to render obvious claim 36. Applicants therefore respectfully request that this §103(a) ground for rejection of claim 36 be withdrawn.

5. No *Prima Facie* Case of Obviousness

It is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. *Cardiac Pacemakers v. St. Jude Medical* 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. *In re Grabiak*, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

The Examiner simply provides no support for how or why one would have been motivated to modify Phillips. The Examiner thus fails to provide any evidence (much less the requisite substantial evidence) to support a *prima facie* case of obviousness

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this §103(a) ground for rejection be withdrawn.

D. *§103(a) Rejections – Phillips, Shavit*

Claims **5-6** stand rejected under §103(a) as being allegedly unpatentable over Phillips in view of Shavit. Applicants believe claims **5-6** to be patentable at least for the reasons presented herein and at least for depending upon a patentable base claim (claim 1). In other words, Phillips fails to teach or suggest limitations as described herein, and Shavit simply fails to make up for the deficiencies of Phillips. Also, as described in Section C.3. herein, the Examiner has utterly failed to provide any evidence in support of any alleged motivation to combine Phillips and Shavit.

Accordingly, at least because the Examiner fails to set forth a *prima facie* case of obviousness for claims **5-6**, the references fail to render claims **5-6** unpatentable. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **5-6** be withdrawn.

V. New Claims

New claims **40-54** are believed to be patentable over the cited references at least for the reasons otherwise presented herein. Further, after reviewing Phillips and Savit, Applicants believe that Phillips and Savit fail to teach, suggest, or render obvious at least:

(i) *displaying, via a touch screen interface, a menu listing a plurality of benefits available for application to the transaction, wherein each of the plurality of benefits is associated with a requirement that the customer perform a task* (claims **40-54**);

(ii) *wherein the selected one of the listed plurality of applicable benefits comprises one or more of: (i) a subsidy that allows the customer to purchase the first item for a second price that is less than the first price; (ii) a supplemental item provided to the customer; (iii) a substitute item associated with a third price that is higher than the first price; (iv) an amount of alternate currency; (v) an amount of frequent flyer miles; (v) an improved term associated with the transaction; (vi) an increase in a bid amount; and (vii) an increase in a probability of the customer receiving the first item* (claim **42**);

(iii) wherein the task associated with the selected one of the listed plurality of applicable benefits comprises one or more of: (i) a requirement that the customer test drive an automobile; (ii) a requirement that the customer apply for a service; (iii) a requirement that the customer purchase one or more supplemental items; (iv) a requirement that the customer exchange a used item; (v) a requirement that the customer visit a second merchant that is different than the first merchant; (vi) a requirement that the customer agree to receive information; (vii) a requirement that the customer dial a telephone number; (viii) a requirement that the customer access a web page; and (ix) a requirement that the customer provide certain information (claim 43);

(iv) wherein the menu listing of the plurality of benefits available for application to the transaction is based at least in part on the first price (claim 44);

(v) wherein the menu listing of the plurality of benefits available for application to the transaction is based at least in part on a category associated with the first item (claim 45);

(vi) wherein the menu listing of the plurality of benefits available for application to the transaction is based at least in part on a current customer acquisition rate associated with the first merchant (claim 46);

(vii) wherein the menu listing of the plurality of benefits available for application to the transaction is based at least in part on a time of day (claim 47);

(viii) wherein the task is based at least in part on the first price (claim 49);

(ix) wherein the task is based at least in part on a category associated with the first item (claim 50);

(ix) wherein the task is based at least in part on a current customer acquisition rate associated with the first merchant (claim 51);

(ix) wherein the task is based at least in part on a time of day (claim 52);

(x) wherein the indication is received from a device associated with the customer (claim 53); or

(xi) wherein the customer device comprises a mobile terminal (claim 54).

VI. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 461-7017 or via e-mail at cfincham@walkerdigital.com, upon the Examiner's convenience.

VII. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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